

REMARKS

Claims 1-69 were pending in this application.

Claims 1-69 have been rejected.

Claims 1, 35, 40, 53, and 69 have been amended as shown above.

Claims 70 and 71 have been added.

Claims 1-71 are now pending in this application.

Reconsideration and full allowance of Claims 1-71 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-10, 12-14, 17-20, 24-38, 40, 44, 45, 47-57, 60, 61, and 64-69 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,379,058 to Petteruti et al. ("*Petteruti*") in view of Mettala, "Bluetooth Protocol Architecture" ("*Mettala*"). The Office Action rejects Claims 11 and 39 under 35 U.S.C. § 103(a) as being unpatentable over *Petteruti* and *Mettala* in view of U.S. Patent No. 5,129,639 to Dehority ("*Dehority*"). The Office Action rejects Claims 15, 16, 41-43, 58, and 59 under 35 U.S.C. § 103(a) as being unpatentable over *Petteruti* and *Mettala* in view of U.S. Patent No. 5,682,379 to Mahany et al. ("*Mahany*"). The Office Action rejects Claims 21-23, 46, 62, and 63 under 35 U.S.C. § 103(a) as being unpatentable over *Petteruti* and *Mettala* in view of U.S. Patent No. 6,163,538 to Brown et al. ("*Brown*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260,

1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (MPEP § 2142).

Claims 1, 35, 53, and 69 have been amended to recite that at least some “keep alive messages” are sent “periodically” after “negotiation” of “configuration parameters.” The proposed *Petteruti-Mettala* combination fails to disclose, teach, or suggest at least these elements of Claims 1, 35, 53, and 69. The Office Action cites various messages in *Petteruti* as anticipating the “keep alive messages” recited in Claims 1, 35, 53, and 69. The various messages in *Petteruti* include wakeup packets, force link packets, data packets, ready packets, accept link packets, handshake packets, no link packets, and broadcast link request packets. (*Col. 6, Lines 56-66*). Figures 4-7C illustrate how these messages or packets are used. For example, Figure 4 illustrates how the wakeup, ready, force link, and accept link packets may be used. However, none of these packets is both (i) sent “periodically” (ii) “after negotiation of the configuration parameters.” The remaining figures also illustrate how the various messages or packets are used, but none of these messages is both (i) sent “periodically” (ii) “after negotiation of the configuration parameters.” As a result, *Petteruti* fails to disclose, teach, or suggest these elements of Claims 1, 35, 53, and 69.

Mettala is cited by the Office Action only as allegedly disclosing the use of a “Bluetooth protocol stack including a Link Control and Adaptation Protocol (LZCAP) that allows an asynchronous connection-less (ACL) connection.” (*Office Action, Page 4, Third paragraph*). *Mettala* is not cited by the Office Action as disclosing, teaching, or suggesting any other elements of Claims 1, 35, 53, and 69, including the elements noted above.

As a result, the Office Action has not established that the proposed *Petteruti-Mettala* combination discloses, teaches, or suggests all elements of Claims 1, 35, 53, and 69. For these

reasons, the Office Action has not established a *prima facie* case of obviousness against Claims 1, 35, 53, and 69 (and their dependent claims).

The dependent claims are patentable due to their dependence from allowable base claims and in light of their own recitations. For example, Claims 12 and 40 recite sending a “set attribute request message ... after negotiating the configuration parameters,” where the “set attribute request message” includes “a coding table concerning a negotiated coding type.” The Office Action cites various portions of *Petteruti* when rejecting these claims. However, none of the cited portions say anything about sending a message containing a “coding table” that concerns a “negotiated coding type” after configuration parameters have been negotiated. As a result, the Office Action has not established that the proposed *Petteruti-Mettala* combination discloses, teaches, or suggests all elements of Claims 12 and 40.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections and full allowance of Claims 1-69.

II. NEW CLAIMS

The Applicant has added new Claims 70 and 71. The Applicant respectfully submits that no new matter has been added. At a minimum, the Applicant respectfully submits that Claims 70 and 71 are patentable for the reasons discussed above. The Applicant respectfully requests entry and full allowance of Claims 70 and 71.

III. CONCLUSION

The Applicant respectfully asserts that all pending claims in this application are in condition for allowance and respectfully requests full allowance of the claims.

SUMMARY


If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fee) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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